



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,566	03/11/2004	Manish K. Deliwala	03292.101710.1	2565
66569 7590 10/31/2007 FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER OBEID, FAHD A	
			ART UNIT 4137	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/708,566	Applicant(s) DELIWALA ET AL.	
	Examiner Fahd A. Obeid	Art Unit 4137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>03/18/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. **Claims 1-19** are pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 11 recites the limitation "CPU". There is insufficient antecedent basis for this limitation in the claim.
4. Claim 12 recites the limitation "the internal structure". There is insufficient antecedent basis for this limitation in the claim.
5. Claim 12 recites the limitation "the billing details". There is insufficient antecedent basis for this limitation in the claim.
6. Claim 12 recites the limitation "the value drivers". There is insufficient antecedent basis for this limitation in the claim.
7. Claim 12 recites the limitation "application profile". There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 4137

8. Claim 13 and 17 recites the limitation "usage". There is insufficient antecedent basis for this limitation in the claim.

9. Claim 13 and 17 recites the limitation "usage" is vague and indefinite. It is unclear whether this limitation refers to "computer usage" or other usage. Thus the limitation is not positively cited.

10. Claim 14 recites the limitation "monitoring usage". There is insufficient antecedent basis for this limitation in the claim.

11. Claim 15 recites the limitation "technology resource". There is insufficient antecedent basis for this limitation in the claim.

Double Patenting Rejection

12. **Claims 1, 10, and 12** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over **claims 1-4** of copending Application No. 10/628,731. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

Instant Claim

1

Claims in Application # 10/628,731

1

Art Unit: 4137

10

1 and 2

12

3 and 4

13. Regarding Claim 1: claim 1 differ from claim 1 in the 10/628,731 application as follows:

- Receiving user information which includes billing information, is encompassed by the term of (receiving billing information).
- Allocating technology resource billings which is encompassed by the terms of (allocating billing information by the various business dimensions such as business processes, organizational information and associated business performance metrics).

14. Regarding Claim 10: claim 10 differ from claims 1 and 2 in the 10/628,731 application as follows:

- Providing descriptive billing statements including total computer usage time, account, project, process or division, etc. is encompassed by the term (reading business dimensions such as business processes, organizational information and associated business performance metrics).
- Computer usage time associated with each identifier, users associated with the computer usage, and processing power associated with each usage which is encompassed by the term (Associated business performance metrics).

Art Unit: 4137

15. Regarding Claim 12: Claim 12 differ from claim 3 in the 10/628,731 application as follows:

- Determining the internal structure of said user entity, including various groups and sub-groups within said entity is encompassed by the term (organizational information includes a plurality of groups, wherein one of said plurality of groups comprises a plurality of sub-groups).
- Determining the billing details of each group within the entity is encompassed by (determining costs incurred by each of said sub-groups and determining costs incurred by each of said groups).

16. Regarding Claim 12: claim 12 is identical to claim 4 in the 10/628,731 application.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

18. **Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ginter (5,910,987).**

Art Unit: 4137

19. Regarding Claim 1: Ginter discloses a method for facilitating the allocation of technology resource billings incurred by a user, said method including:

- Receiving user information relating to the technology resource, wherein said user information includes at least one of an identifier (user identification; see col 40 line 62), billing information (col 304 lines 43-65), business model file, application profile, value driver, user level, geographic area, project, zone, third party provider, loyalty information and rule (collecting billing; see col 179 lines 58-67 and claim 1).

20. Allocating said technology resource billings based on said user information (a user setting a limit on the price for electronic documents that the user is willing to pay without prior express user authorization; see col 28 lines 12-31, col 304 lines 43-65, col 306 lines 5-48, col 307 lines 39-67, and claim 1).

21. Regarding Claim 2: Ginter discloses a method of claim 1 wherein said technology resource includes at least one of computer usage (col 10 lines 1-25), wherein said computer usage includes computing time obtained from an outsourced provider, telephony resource usage (col 317 lines 1-11), manufacturing cycles and production runs.

22. Regarding Claim 3: Ginter discloses a method of claim 1 wherein receiving user information includes receiving user information at a controller (fig 50A, col 300 lines 63-

Art Unit: 4137

67, and col 306 lines 27-48).

23. Regarding Claim 4: Ginter discloses a method of claim 1, wherein said receiving an identifier from said user includes automatically recognizing said user (fig 15A, cols 24-25 lines 63-67 & 1-2).

24. Regarding Claim 5: Ginter discloses a method of claim 1, wherein said receiving an identifier from said user includes automatically recognizing said user and assigning an identifier to said user (fig 27, col 121-122 lines 25-67 & 1-55).

25. Regarding Claim 6: Ginter discloses a method of claim 1, wherein said allocating said technology resource billings based on said user information includes allocating loyalty points (such as discounts, gift certificate, or coupons) to said user (col 157 lines 32-36, col 244 lines 6-10, and col 307 lines 45-67).

26. Regarding Claim 7: Ginter discloses a method of claim 1, wherein said allocating said technology resource billings based on said user information includes reducing said billings by a monetary value of loyalty points (col 157 lines 32-36, col 244 lines 6-10, and col 307 lines 45-67).

27. Regarding Claim 8: Ginter discloses a method of claim 1, wherein said allocating said technology resource billings based on said user information includes at least one of

Art Unit: 4137

transferring, pooling and gifting said loyalty points (col 157 lines 32-36, col 244 lines 6-10, and col 307 lines 45-67).

28. Regarding Claim 9: Ginter discloses a method of claim 1 further including providing descriptive billing statements including said user information (the billing method describes the pricing algorithm that should be used in the billing; see col 188 lines 53-67).

29. Regarding Claim 10: Ginter discloses a method of claim 1 further including providing descriptive billing statements (the billing method describes the pricing algorithm that should be used in the billing; see col 188 lines 53-67) including at least one of said user information, total computer usage time, computer usage time associated with each identifier, account, project, process or division, time periods of computer usage, users associated with the computer usage during any or all of the time periods, authorizations received, rule engine guidelines used during the computer usage, notifications sent by the controller, accounts billed for the usage, processing power associated with each usage, provider providing the computing time, computer usage and billings associated with business model files, application profiles, value drivers, analysis, statistics, graphical display of usage, and graphical display of billings (receiving a bill delivered through use of VDE, wherein such a bill is derived from said usage; see col 301 lines 31-60).

Art Unit: 4137

30. Regarding Claim 11: Ginter discloses a method of claim 1, further including adjusting said billings based upon at least one of CPU-seconds used, CPU-seconds expected to be used, volume discount, stepped-type of pricing, peak/off-peak usage, geographic location, services provided, performance expectations, location, service level scoring, CPU cycle, local power consumption costs, physical site security, increased site security, additional operational procedures needed to support increased sensitive data, level of fail over needed, service level agreements, and account data privacy requirements (col 157 lines 32-36, col 244 lines 6-10, and col 307 lines 49-55).

31. Regarding Claim 12: Ginter discloses a method of claim 1 wherein said step of receiving user information further includes: determining the internal structure of said user entity, including various groups and sub-groups within said entity (fig 33, fig 81, col 311 lines 51-62, col 314 lines 1-25); determining the billing details of each group within the entity (col 311 lines 51-62); determining the value drivers of the entity (fig 33, fig 81, col 311 lines 51-62, col 314 lines 1-25); and determining application profiles of the entity (an entity has user name and password where it contains privacy information such as profile; see fig 72A, col 35 lines 8-11, col 283 lines 1-3, and col 290 lines 21-49).

32. Regarding Claim 13: Ginter discloses a method for facilitating managing computer usage, wherein said computer usage includes computing time obtained from an outsourced provider, said method including:

Art Unit: 4137

- Monitoring said computer usage (determining usage as related to billing and monitoring for current usage; see col 145 lines 52-55, col 271 lines 23-48, and col 317 lines 1-11).
- Notifying a user of said usage (claim 1).

33. Regarding Claim 14: Ginter discloses a method of claim 13, wherein said monitoring usage of said technology resource includes monitoring in at least one of substantially real-time, a pre-established time period and a random period (col 317 lines 1-11).

34. Regarding Claim 15: Ginter discloses a method of claim 13, wherein said notifying said user includes notifying said user via at least one of phone, email, pager, cell phone, personal digital assistant, and fax (col 53 lines 54-67, col 235 lines 8-25, col 269 lines 53-67).

35. Regarding Claim 16: Ginter discloses a method of claim 13, wherein said notifying said user includes providing at least one of a signal, usage clock, and monetary usage value to said user (col 117 lines 1-15).

36. Regarding Claim 17: Ginter discloses a method of claim 13 further including performing data analysis of said usage (usage analysis information; see col 284 58-65,

Art Unit: 4137

col 287 lines 9-10, and col 287 lines 49-62).

37. Regarding Claim 18: Ginter discloses a method of claim 13 further including suggesting cost efficient usage practices (VDE can provide efficient reusable, modifiable, and consistent means for distribution, usage control, usage payment, usage auditing, and usage reporting; see fig 72D, col 8 lines 17-25, col 98 lines 56-67).

38. Regarding Claim 19: Ginter discloses a method of claim 13 further including requesting bids based upon said monitoring step (col 246-247 lines 54-67 & 1-9, col 312 lines 41-52, and col 317 lines 12-28).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fahd A. Obeid whose telephone number is 571-270-3324. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Akm Ullah can be reached on 571-272-2361. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 4137

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fahd Obeid
Patent Examiner


AKM ULLAH
SUPERVISORY PATENT EXAMINER